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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,506	01/16/2001	Timothy K. Doherty	BGE-1	5918

7590 09/11/2003  
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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/761,506

Applicant(s)

DOHERTY ET AL. NH

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Drawings***

This application has been filed with informal drawings, which are acceptable for examination purposes only. The drawings contain improper shading that may affect clarity when reproduced. Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

Figures 3 and 6 contain various trademarked logos forming part of the claimed design. The specification must be amended to include a statement preceding the claim identifying the trademark material forming part of the claimed design and the name of the owners of the trademark.

### ***Specification***

The use of the trademarks Nike, Ford, Amazon.com, McDonalds, Rolex and Kodak has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-7, 10-26, 32-33 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoyle U.S. Patent No. 6,141,010.**

Referring to claim 1. Hoyle discloses an Internet advertising system comprising:

- A multimedia presentation containing an embedded placeholder (Fig. 5 and Fig. 5a);
- A set of advertisements corresponding to the embedded placeholder, each advertisement being indexed by at least one demographic indicator (abstract);
- Means for identifying at least one demographic characteristic of a user (column 2, lines 22-44);
- Means for selecting one advertisement from the set of advertisements, the selector means including a comparison of the user's at least one demographic characteristic with the at least one demographic indicator of each advertisement to select the most relevant advertisement for the user (column 5, line 6 to column 6, line 5);
- Means for inserting the selected advertisement into the embedded placeholder of the multimedia presentation, the inserter means creating a seamless advertisement dynamically contained in the multimedia (column 5, line 6 to column 6, line 5, Fig. 5 and Fig. 5a);

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- Presentation and targeted to the user's demographic characteristics (column 5, line 6 to column 6, line 5); and
- Means for delivering the multimedia presentation to the user (column 5, line 6 to column 6, line 5).

Referring to claim 2. Hoyle further discloses a system comprising a hyperlink in the advertisement contained in the multimedia presentation (column 14, line 59 to column 5, line 28).

Referring to claim 3. Hoyle further discloses a system wherein the hyperlink in the advertisement is a hyperlink to an advertiser's website (column 14, line 59 to column 5, line 28).

Referring to claim 4. Hoyle further discloses a system wherein the multimedia presentation is an animation (column 3, lines 30-67).

Referring to claim 5. Hoyle further discloses a system wherein the animation is created using Flash (column 3, lines 30-67).

Referring to claim 6. Hoyle further discloses a system wherein the Flash animation is an original presentation (column 3, lines 30-67).

Referring to claim 7. Hoyle further discloses a system wherein the Flash animation is a pre-existing presentation and the embedded placeholder is then added to the pre-existing presentation (column 3, lines 30-67).

Referring to claim 10. Hoyle further discloses a system wherein the identifier means includes cookies generated by an Internet browser of the user (column 17, lines 27-45).

Referring to claim 11. Hoyle further discloses a system wherein the identifier means includes a survey completed by the user (Fig. 8, "Send Form to User").

Referring to claim 12. Hoyle further discloses a system wherein the inserter means is a computer program (claim 16).

Referring to claim 13. Hoyle further discloses a system wherein the computer program is Generator (claim 16).

Referring to claim 14. Hoyle further discloses a system wherein the computer program is stored on a first server and the multimedia presentation containing the embedded placeholder is also stored on the first server (claim 16).

Referring to claim 15. Hoyle further discloses a system wherein the computer program is stored on a first server and the multimedia presentation containing the embedded placeholder is stored on a second server (claim 16).

Referring to claim 16. Hoyle further discloses a system wherein the delivery means is an Internet connection between a first server storing the multimedia presentation containing the embedded placeholder and a computer operated by the user (Fig. 4)

Referring to claim 17. Hoyle further discloses a system comprising a syndication network (Fig. 4).

Referring to claim 18. Hoyle further discloses a system wherein the syndicated network collects the multimedia presentation and the selected advertisement, and the syndication network delivers the multimedia presentation containing the selected advertisement to the user's computer (column 5, line 6 to column 6, line 5).

Referring to claim 19. Hoyle further discloses a system wherein the syndicated network collects the multimedia presentation and the selected advertisement separate from one another, and a server in the syndication network inserts the selected advertisement into the multimedia presentation (column 5, line 6 to column 6, line 5).

Referring to claim 20. Hoyle further discloses a system wherein the syndicated network collects the multimedia presentation having the selected advertisement inserted therein previous to entering the syndication network (column 5, line 6 to column 6, line 5).

Referring to claim 21. Hoyle further discloses a system wherein the syndicated network collects information relating to the identifier means from the user's computer and delivers the identifier information to the selector means (column 5, line 6 to column 6, line 5).

Referring to claim 22. Hoyle further discloses a system that comprises a media buyer providing at least a portion of the set of advertisements (Fig. 4).

Referring to claim 23. Hoyle further discloses a system wherein the media buyer receives information relating to the identifier means from the user's computer (column 5, line 6 to column 6, line 5).

Referring to claim 24. Hoyle further discloses a system wherein the identifier information from the syndication network is further delivered to a media buyer (column 5, line 6 to column 6, line 5).

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Referring to claim 25. Hoyle further discloses a system wherein the identifier information is delivered from the syndication network to the media buyer to the selector means (column 5, line 6 to column 6, line 5).

Referring to claim 26. Hoyle further discloses a system wherein the identifier information is delivered from the syndication network to the media buyer and the identifier information is also delivered from the syndication network to the selector means (column 5, line 6 to column 6, line 5).

Referring to claim 32. Claim 32 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 33. Hoyle further discloses a system wherein the selector randomly selects the advertisement (column 5, line 6 to column 6, line 5).

Referring to claim 37. Claim 37 is rejected under the same rationale as set forth above in claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 8-9, 27-31 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle U.S. Patent No. 6,141,010 in view of Gupta U.S. Patent No. 6,487,538.**



Referring to claim 8. Hoyle discloses a system according to claim 1 as indicated supra. Hoyle does not expressly disclose the system wherein the multimedia presentation includes at least two embedded placeholders. Gupta discloses the system wherein the multimedia presentation includes at least two embedded placeholders (Gupta: column 11, lines 43-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Hoyle to have included the limitations of Gupta as discussed above because it is desirable for advertisements to target specific audiences and persons that may be interested in the specific goods or services being advertised (Gupta: column 1, lines 21-34).

Referring to claim 9. Hoyle discloses a system according to claim 8 as indicated supra. Hoyle does not expressly disclose the system comprising multiple sets of advertisements, each set of advertisements corresponding to one of the at least two embedded placeholders. Gupta discloses the system comprising multiple sets of advertisements, each set of advertisements corresponding to one of the at least two embedded placeholders (column 11, lines 43-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Hoyle to have included the limitations of Gupta as discussed above because it is desirable for advertisements to target specific audiences and persons that may be interested in the specific goods or services being advertised (Gupta: column 1, lines 21-34).

Referring to claims 27-30. Hoyle discloses a system according to claim 8 as indicated supra. Hoyle does not expressly disclose the system comprising:

- An advertisement charge to the sponsor of the selected advertisement delivered in the multi-media presentation wherein the charge is paid to an owner of the multimedia presentation;
- Is apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisements; or
- Is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the inserted advertisement, and an owner of the delivery means for providing the multimedia presentation to the user.

Gupta discloses the system comprising:

- An advertisement charge to the sponsor of the selected advertisement delivered in the multi-media presentation wherein the charge is paid to an owner of the multimedia presentation (Gupta: column 4, lines 26-37);
- Is apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisement (Gupta: column 4, lines 26-37); or
- Is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the inserted advertisement, and an owner of the delivery means for providing the multimedia presentation to the user (Gupta: column 4, lines 26-37).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Hoyle to have included the limitations of Gupta as discussed above so advertisements would be able to appear on web sites that do not normally attract advertisers (Gupta: column 6, lines 10-23).

Referring to claim 31. Hoyle further discloses the system wherein the delivery means is a syndication network (Fig. 4).

Referring to claim 36. Claim 36 is rejected under the same rationale as set forth above in claims 1-31.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

LeMole, U.S. Patent No. 6,009,410, December 28, 1999, discloses a method and system for presenting customized advertising to a user on the world wide web.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

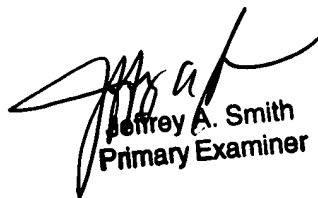
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746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

September 3, 2003



Jeffrey A. Smith  
Primary Examiner